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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/471,749	12/23/99	HILLMAN J	PF-0519-1DIV

HM22/0404

INCYTE PHARMACEUTICALS INC
PATENT DEPARTMENT
3174 PORTER DRIVE
PALO ALTO CA 94304

EXAMINER	
HARRIS,A	
ART UNIT	**PAPER NUMBER**
1642	3

DATE MAILED: 04/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/471,749	Applicant(s) Hillman et al.
	Examiner Alana M. Harris, Ph. D.	Group Art Unit 1642

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-20* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-20* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 2 and 13, drawn to a substantially purified polypeptide, classified in class 530, subclass 350.

II. Claims 3-12, drawn to an isolated and purified polynucleotide, classified in class 536, subclass 23.1.

III. Claim 14, drawn to a purified antibody, classified in class 530, subclass 387.1.

IV. Claim 15, drawn to a purified agonist, classified in class 530, subclass 300.

V. Claim 16, drawn to a purified antagonist, classified in class 530, subclass 300.

VI. Claim 17, drawn to a method of treating or preventing a disorder, comprising administering a pharmaceutical composition, classified in class 424, subclass 1.11.

VII. Claim 18, drawn to a method of treating or preventing a disorder, comprising administering an antagonist, classified in class 514, subclass 2.

VIII. Claims 19 and 20, drawn to a method for detecting a polynucleotide, classified in class 436, subclass 6.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I-V are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups VI- VIII differ in the method objectives, method steps and parameters and in the reagents used.

Inventions of Group I and of Group VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the polypeptide of Group I can be used in *in vitro* diagnostic methods.

Inventions of Group II and of Group VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the polynucleotide Group II can be used in *in vivo* gene therapy methods.

Inventions of Group V and of Group VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the antagonist of Group V can be used in *in vitro* diagnostic methods.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Attempts to reach Diane Hamlet-Cox by telephone on April 3, 2000 to request an oral election to the above restriction requirement were unsuccessful.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, whose telephone number is (703) 306-5880.

NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER